

REMARKS

Applicants have considered the August 11, 2005 Office Action regarding the above-identified application, and the claim amendments above together with these remarks are presented in a bona fide effort to respond to all issues raised in that Action. The claims have been amended to distinguish over applied art. It is believed that the amended claims are allowable, and Applicants respectfully request a prompt favorable reconsideration of this matter.

Applicants filed three Information Disclosure Statements prior to the first Office Action, and Applicants filed yet another Information Disclosure Statement on August 19, 2005 (just after the second Office Action). The first Office Action (January 31, 2005) included document citation forms (PTO- 1449s) from the three earliest Statements. However, the copy of the form from the October 6, 2003 Statement was only partially initialed. On that form, the citations of the two foreign patent documents were initialed, but the citation of the literature document at the bottom was not. It is believed that a copy of the literature document in question was submitted with that Statement and should be in the application file. Since the citation of the literature document was not crossed-out, presumably the Examiner considered the document during examination and preparation of the first Action. It is requested that the Examiner consider all of the documents cited in various Statements, specifically including the literature document cited in the October 6, 2003 Statement as well as the newly cited documents identified in the August 19, 2005 Statement, as part of the reconsideration of this application, and that the Examiner indicate consideration by initialing the forms alongside **all** of the citations and returning the fully initialed document listings (forms PTO- 1449) with the next Official communication regarding this case.

Also, it appears that the Examiner has not yet considered and acknowledged Applicants' claim of priority. It is requested that the reconsideration of this application include consideration

of the claim of priority and acknowledgement that the priority document has been filed in the parent (09/948,698) of this application.

As noted, claims have been amended to distinguish over applied art. Care has been taken to avoid introduction of new subject matter. Claims 11 and 13 have been amended to add aspects of the service center. Claims 15 and 17 have been amended to add coupon processing elements, examples of which are disclosed at the service center in the exemplary embodiments described in the specification and shown in the drawings. Claims 11 and 15 correspond to the first embodiment (Fig. 1), whereas claims 13 and 17 correspond to the second embodiment (Fig. 6). With regard to claims 15 and 17, attention also is directed to the discussion of the integration system on page 9, lines 11-15 of the specification. An example of a history appears in Fig. 2A, and history storing means are shown at 65 in the drawings for both embodiments (see Figs. 1 and 6). It is respectfully submitted that new claims 28 and 30 find support in Fig. 2A and the description thereof. New claim 29 is supported by Fig. 2A and the discussion of the service center 60 starting on line 5 of page 14 of the specification. New claim 31 finds support in Figs. 3A to 3C and the descriptions thereof. In view of the support in the original specification and drawings, it is submitted that the claim amendments (revisions and submissions of new claims) should raise no concern as to adequacy of the disclosure or written description and do not introduce any new subject matter into the application.

The indefiniteness rejection of claim 19 should be moot in view of the cancellation of that claim. Care has been taken in amending the claims to insure that the language the Examiner found indefinite does not appear in any of the amended claims. Withdrawal of the indefiniteness rejection is respectfully requested.

The other issues raised in the latest Action relate to an art rejection of previous versions of the claims. All of the previous versions of claims 11-27 were rejected under 35 U.S.C. §103

over U.S. Patent No. 5,287,181 to Holman in view of U.S. Patent No. 4,674,041 to Lemon. It is respectfully submitted that the amended claims above patentably distinguish over the combination of Holman and Lemon, therefore the art rejection should be withdrawn.

The claims now recite several different features implemented on the program/commercial message transmission side (i.e. the side of the service center or the broadcasting/transmitting system). The recited features relate to management of the coupon with linking to the program or the commercial message as "history" when the transmission side issues and transmits the coupon (see for example Fig. 2A and numeral 65).

Each of the independent claims (1, 13, 15 and 17), for example, now recites history storing means for storing a history including an identifier of the shopping coupon and information on the program or commercial message when the coupon transmitting means transmits the shopping coupon to the receiver. Claim 1 further recites calculating means for calculating the number of issuances of the shopping coupon for each program or commercial message based on the history, whereas claim 15 includes a recitation of coupon issuance number analyzing means for calculating the number of issuances of the shopping coupon for each program or commercial message based on the history. Claim 13 includes a recitation of calculating means for calculating the number of uses of the shopping coupon for each program or commercial message based on history that is updated when a store terminal indicates use of the coupon. Claim 17 includes recitations of history updating means for updating the stored history in accordance with the received coupon use status and coupon use number analyzing means for calculating number of coupons used for each program or commercial message based on the updated history. It is respectfully submitted that the combination of Holman and Lemon does not suggest the history storing means recited in each independent claim and does not suggest either the recited determination of issuance number based on history (as recited in either claim

11 or claim 15) or the recited determination of number of uses based on updated history (as recited in either claim 13 or claim 17).

The Holman patent shows the home unit 1 which generates coupons in response to encoded coupon-related data received in a television signal. The home unit 1 displays the message such as “\$1 discount on 6-pack of Coke®” with the commercial on TV screen 38. If the audience participant pushes the coupon button 11, the home unit 1 stores the coupon-related data for each commercial in the internal memory. Later, when the audience participant pushes the load coupon button 19, the home unit 1 transfers the coupon to a magcard for redemption (Column 6, lines 34-64). Figs. 8 and 9 show terminal systems for coupon redemption. However, Holman is silent on the processing implemented on the commercial transmission side. Holman does not specifically disclose any storing of a history including a transmitted coupon identifier together with commercial or program information regarding the commercial or program with which the coupon information was transmitted. Holman therefore does not show any device corresponding to the “history storing means” recited in the independent claims now pending in the present application.

In Holman, the home unit 1 is assumed to be placed on the top of a television receiver (Column 5, lines 41-42). Hence, Holman’s home unit is set at the television signal receiving side, which most closely corresponds to the “receiver” mentioned in claims 11 and 13 as supplying the request to the service center. As noted, Holman’s Figs. 8 and 9 show systems for coupon redemption, analogous to the store terminal mentioned in claim 13 as providing use data. By contrast, claims 11 and 13 expressly recite the service center in communication with the transmission side, i.e. to supply coupon information to the broadcasting or transmitting element, for communication to the audience receiver, e.g. via a network. Accordingly, the home unit and

redemption terminals of Holman are different from the service center or the broadcasting or transmitting element recited in claims 11 and 13.

The rejection cites Lemon for alleged teachings to track issuances of coupons and redemptions of coupons. The Lemon patent shows a standalone terminal for issuing coupons and a host to monitor and control the number of coupons issued and redeemed. Lemon, however, does not teach broadcast or transmission of coupon information with a program or commercial message and does not teach correlating issuance or use data between the coupons and the program or commercial message. Accordingly, Lemon does not show the history storing means recited in the independent claims.

In the detailed action, the Examiner indicated that Lemon shows the concept of tracking the number of issued coupons. However, the tracked object of Lemon is different from that tracked in the claims. The present invention tracks the number of issued coupons (claims 11 and 15) or the number of used coupons (claims 13 and 17) for each program or commercial message, while Lemon tracks only the number of issued coupons and/or redeemed coupons. In Lemon, it is impossible to know the advertising effects of the program or commercial message since there is no linking information between the coupon and the program or commercial message.

Since neither Holman nor Lemon teaches tracking in relation to the broadcast or transmitted program or commercial, the combination of those to documents still would not satisfy the above-discussed recitations of the independent claims. Hence all pending claims should be patentable over the art; and Applicants request that the Examiner withdraw the art rejection and allow the claims.

It is believed that this response addresses all issues raised in the August 11, 2005 Action. However, if any further issue should arise that may be addressed in an interview or by an

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Examiner's amendment, it is requested that the Examiner telephone Applicants' representative at the number shown below.

To the extent necessary, if any, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP

A handwritten signature in black ink, appearing to read "Keith E. George", is written over a horizontal line.

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